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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/876,812	06/17/1997	JOEL S. DOUGLAS	018176-070	5409

7590                    01/13/2003

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[REDACTED] EXAMINER

CHIN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
1641	

DATE MAILED: 01/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/876,812</b>	Applicant(s) <b>Douglas et al</b>	Examiner <b>Chris L. Chin</b>	Art Unit <b>1641</b>
			

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on Aug 7, 2002
  - 2a)  This action is FINAL.      2b)  This action is non-final.
  - 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- Disposition of Claims**
- 4)  Claim(s) 1-16, 52-59, and 61-83 is/are pending in the application.
  - 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
  - 5)  Claim(s) 1-16 and 61-83 is/are allowed.
  - 6)  Claim(s) 52-55 and 59 is/are rejected.
  - 7)  Claim(s) 56-58 is/are objected to.
  - 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some\* c)  None of:
  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).\*See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 U.S.C. § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 52 is rejected under 35 U.S.C. 102(b) as being anticipated by Bogart et al.  
Bogart et al (U.S. Patent 5,468,606) discloses a device for detecting the presence or amount of an analyte of interest. The disclosed device has numerous embodiments as shown in the figures and described in the specification. The disclosed device is essentially a multilayered optical device comprising a substrate and various layers thereon with a layer of analyte specific reagent as its uppermost layer. For use in a reflection mode, the substrate can be a glass substrate coated with aluminum. The aluminum coated glass can be coated with a layer of amorphous silicon to provide optical characteristics (col. 15, lines 38-67). Instead of glass, plastics, fused silica, and ceramic materials can be used (col. 12, lines 58-67, and col. 15, lines 4-7).

In the reflection mode of the device of Bogart et al, the layer of aluminum is considered to read on the single substrate of the instant device. The layer of glass or plastic on the aluminum is considered to read on the non-conductive surface morphology-improving coating. Glass or

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plastic are considered non-conductive materials and its presence on the aluminum changes or improves the surface morphology of the aluminum surface. The layer of amorphous silicon is considered to read on the layer of amorphous semiconductor material of the instant device.

In response to this rejection, Applicants argue that Bogart does not disclose a device having the specific order of layers as presently claimed.

Applicant's arguments have been considered but are not convincing. Bogart discloses an extensive list of materials for the substrate, such as aluminum, and other materials, such as glass or plastics and amorphous silicon, for the layers that comprise the multilayered device which provides for an extensive list of possible embodiments. As it is not necessary for Bogart to show every possible embodiment of the disclosed multilayered device, the disclosure of Bogart is sufficient to anticipate the instantly claimed device.

***Claim Rejections - 35 U.S.C. § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 53-55 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bogart et al.

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See above for the teachings of Bogart et al.

Bogart et al differs from the instant invention in failing to teach the specific thicknesses recited in the instant claims.

However, the optimum thickness for the layers in the device of Bogart et al to provide the optimum optical signal in response the presence or amount of analyte can be determined by routine experimentation and thus would have been obvious to one of ordinary skill in the art.

***Allowable Subject Matter***

5. Claims 56-58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 1-16 and 61-83 are allowed.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Chin whose telephone number is (703) 308-3991. The examiner can normally be reached on Monday-Thursday from 10:00 am to 7:30 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

cchin/cc  
January 12, 2003

*Christopher L. Chin*  
CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP 1800-1641  
1/12/03